

Serial No. 10/797,486

Amend. In Resp. to Off. Act. of Aug. 1, 2006

UTILITY PATENT

B&D No. JK01261

REMARKS

Applicants have canceled Claims 7, 14 and 29, and amended Claims 21-28 and 30-51.

Pending in the present application are therefore Claims 1-6, 8-13, 15-28 and 30-51.

The Examiner objected to the numeration of Claims 22-50. In response, Applicants have renumbered the claims as required by the Examiner.

The Examiner objected to the drawings under 37 CFR § 1.83(a) for not showing the elements called for in Claims 7, 14 and 29. In response, Applicants have canceled Claims 7, 14 and 29, rendering such objection moot.

The Examiner rejected Claims 1-14, 17-19, 23-29 and 32-35 under 35 USC § 103(a) as being unpatentable over US Pub. No. 2002/0017175 ("Gass") in view of US Patent No. 5,436,613 ("Ghosh"). In addition, the Examiner rejected Claims 22 and 36 under 35 USC § 103(a) as being unpatentable over Gass in view of Ghosh and further in view of US Pub. No. 2003/0169956 ("Lange"). These rejections are respectfully traversed.

Claim 1 calls for a power tool, comprising a working element for performing a task on a workpiece, a light source arranged to project a beam of light adjacent the interface between the working element and the workpiece, and a detector configured to detect the presence of a human body part in the beam of light, wherein the detector is communicatively coupled to the power tool so as to stop operation of the working element, if a human body part is detected.

Independent Claims 8 and 22 have similar elements.

Gass admittedly teaches a power tool with a working element for performing a task on a

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workpiece and a detecting system for detecting a human body part. However, Gass does not disclose a light source arranged to project a beam of light adjacent the interface between the working element and the workpiece, or the detector detecting the presence of a human body part in the beam of light.

The Examiner relies on Ghosh for such teachings. In particular, the Examiner relies on a statement that infrared systems "have been used in designing detection systems of human presence." However Ghosh does not teach how such infrared systems detect human presence, or how such system is structured.

The Examiner should not combine Gass and Ghosh as the Examiner has not met the *prima facie* case of obviousness for combining such references for several reasons.

First, according to MPEP § 2143, the Examiner must show that there is "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings."

In the present case, there is no suggestion or motivation to Gass's detection system with the infrared system mentioned in Ghosh because Ghosh does not suggest the desirability of the claimed invention. According to MPEP § 2132.01(I), "the prior art must suggest the desirability of the claimed invention." Ghosh does not suggest the desirability of using a light source for detecting a human body part.

Instead, it declares that "none of the prior art devices identified above is capable of discriminating between a human and an inanimate object." Ghosh, col. 2, lines 66-68. Ghosh thus teaches away from using infrared systems and teaches persons skilled in the art to use

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instead capacity systems. Ghosh, col. 4, lines 30-34. Accordingly, Ghosh does not teach the desirability of the claimed invention which relies on light, rather than capacitive systems.

Furthermore, if the "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01(V) (*citing In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

As discussed above, Ghosh describes infrared systems as unable to "discriminat[e] between a human and an inanimate object." Ghosh, col. 4, lines 30-34. On the other hand, the intended purpose of Gass is to stop motion of the blade when a human body part is detected, not when a workpiece contacts the saw blade. If Gass and Ghosh are combined, the resulting power tool will stop motion of the blade when either a human body part or an inanimate object is detected, as Ghosh's infrared system is unable to "discriminat[e] between a human and an inanimate object." Such modification would render the Gass device unsatisfactory for its intended purpose, i.e., stop motion of the blade when a human body part is detected, but not when a workpiece contacts the saw blade. Therefore, there is no suggestion or motivation to make proposed modification.

Further, for a prima facie case of obviousness to exist, the Examiner must show that "there must be a reasonable expectation of success." MPEP § 2143. As discussed above, the purpose of the present invention is to provide a power tool that detects the presence of a human body part. If Gass and Ghosh are combined, the resulting power tool will not be able to do so as Ghosh's infrared system is unable to "discriminat[e] between a human and an inanimate object." Ghosh, col. 4, lines 30-34. Accordingly, it would be unreasonable to expect that Gass and

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Ghosh's infrared system would be able to "discriminate[e] between a human and an inanimate object," when Ghosh admits that its own infrared system cannot do so.

Finally, for a prima facie case of obviousness to exist, the prior art references "must teach or suggest all the claim limitations." MPEP § 2143. In the present case, Ghosh is silent as to the structure of the infrared system. Accordingly, there is no teaching, for example, as to where the infrared light should be directed or how to detect the human body part. Accordingly, even if Gass and Ghosh were combined, such combination would not show "a light source arranged to project a beam of light adjacent the interface between the working element and the workpiece," as called for in Claim 1.

Because the Examiner has failed to establish all three elements required for a prima facie case of obviousness, the Examiner cannot combine Gass and Ghosh to render unpatentable Claim 1 and its dependent claims.

Furthermore, independent Claims 8 and 22 have similar elements, such as the light source and the detector configured to detect the presence of a human body part. Similarly, because the Examiner has failed to establish all three elements required for a prima facie case of obviousness, the Examiner cannot combine Gass and Ghosh to render unpatentable Claims 8 and 22 and their respective dependent claims.

In view of the foregoing, Applicants believe the application to be in condition for formal allowance. Accordingly, allowance of Claims 1-6, 8-13, 15-28 and 30-51 is respectfully requested.

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No fee is due. Nonetheless, the Commissioner is authorized to charge payment of any fees due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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